

REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

In the present Amendment, claims 9 and 23-39 have been amended and claims 41-44 have been added. Also, claims 40-41 have been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 9, 23-39 and 41-44 are pending in this application.

No new matter has been added by way of these amendments because each amendment is supported by the present specification. For example, the amendments to claims 9 and 23 incorporate the subject matter of canceled claims 40-41, and Applicants further note page 15, fourth full paragraph of the specification. The change from “A” to “The” in the various claims are clarifying amendments and not narrowing in scope. Thus, Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

No new matter has been added by way of the new claims, which have been added as being directed to other embodiments of the present invention. Support for new claims 42-43 is found at the bottom of page 15 and the top of page 16 of the present specification. New claim 44 has support, for example, in the paragraph bridging pages 9-10 and page 15, fourth full paragraph.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Substance of the Interview

Applicants thank the Examiner for his time, helpfulness and courtesies extended to Applicants' representative during the Interview of June 30, 2009. The assistance of the Examiner in advancing prosecution of the present application is greatly appreciated. In compliance with M.P.E.P. § 713.04, Applicants submit the following remarks.

The Interview Summary form amply summarizes the discussions at the Interview. Various ways of addressing the prior art rejections were discussed, and suggestions were discussed that may be drafted to cover particular aspects of the invention as not described by the prior art. Applicants note the amendments to claims 9 and 23 as shown herein.

Issues under 35 U.S.C. 112, First Paragraph

Claims 9 and 23-41 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement (see Office Action, pages 2-3). Applicants respectfully traverse.

While Applicants disagree with this rejection, reconsideration is requested in light of the changes to claims 9 and 23 as shown herein. Applicants note that throughout the specification it is described that the candidate substance has to have a pharmacological action (e.g., antidiabetic)

similar to that of the thiazolidine derivative. Regarding the comments that pioglitazone has other pharmacological uses, this compound is known to have antidiabetic effects as even disclosed on the FDA website (see, e.g., <http://www.fda.gov/bbs/topics/ANSWERS/ANS00965.html>). Applicants respectfully request reconsideration and withdrawal of this rejection.

Issues under 35 U.S.C. 112, Second Paragraph

Claims 9 and 23-41 stand rejected under 35 U.S.C. § 112, second paragraph for lack of definiteness (see Office Action, pages 3-4). Applicants respectfully traverse.

While Applicants disagree with this rejection, reconsideration is requested in light of the changes to claims 9 and 23 as shown herein. Applicants note that throughout the specification it is described that the candidate substance has to have a pharmacological action similar to the thiazolidine derivative, wherein the goal of the invention is to screen for such antidiabetic substances. Thus, reconsideration and withdrawal of this rejection are respectfully requested..

Issues under 35 U.S.C. 102(e)

Claims 9, 23-27, 32, 33 and 38-41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent Publication 2007/0105122 to Ota et al. (hereinafter "Ota '122") (Office Action, pages 4-5).

Also, claims 9, 23-33 and 38-41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent Publication 2007/0224201 to Wu et al. (hereinafter "Wu '201") (Office Action, page 5-6).

Applicants respectfully traverse each of the outstanding rejections. Applicants submit that neither of Ota '122 nor Wu '201 teaches or suggests the claimed screening method for substances that have a mechanism of pharmacological action similar to that of, e.g., pioglitazone. Further, reconsideration is requested in light of the changes to claims 9 and 23 as shown herein. Applicants note that throughout the specification it is described that the candidate substance has to have a pharmacological action (e.g., antidiabetic) similar to the thiazolidine derivative. Applicants also note the third step added to claims 9 and 23. Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections.

Issues under 35 U.S.C. 103(a)

Claims 34 and 35 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by Wu '122 in view of the present specification at page 15. Since claims 34 and 35 depend on claims 9 and 23, respectively, Applicants respectfully traverse for the reasons specified above. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501)

Application No. 10/569,791

Docket No.: 1254-0305PUS1

Art Unit 1647

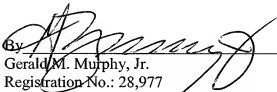
Reply to Office Action of March 12, 2009

at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: JUL 09 2009

Respectfully submitted,

By 

Gerald M. Murphy, Jr.

Registration No.: 28,977

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant